

### *Status of the claims*

Claims 1, 3, 4, 7, 9-12, 16-18, 25-29, 31-35, and 37-41 are pending. Claims 2, 5, 6, 8, 13-15, 19-24, 30, and 36 have been canceled without prejudice. Claims 1, 16, 27-29, 31, and 38-41 have been amended. Claims 1, 16, 27, 28, 29, 31, and 38-41 are independent.

### *Requested action*

Applicants respectfully request the Examiner to reconsider and withdraw the outstanding objections and rejections in view of the foregoing amendments and the following remarks.

Applicants also respectfully request that this Amendment be entered. This Amendment could not have been presented earlier as it was earnestly believed that the claims on file would be found allowable. Given the Examiner's familiarity with the application, Applicants believe that a full understanding and consideration of this Amendment would not require undue time or effort by the Examiner. Moreover, for the reasons discussed below, Applicants submit that this Amendment places the application in condition for allowance. At the very least, it is believed to place the application in better form for appeal. Accordingly, entry of this Amendment is believed to be appropriate and such entry is respectfully requested.

### *Rejections*

Claims 1-6, 8-14, 16-23, 27-29, 30-31, and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the patent to Judson (U.S. Patent No. 5,848,413) in view of the patents to Yoda (U.S. Patent No. 5,848,413), Nielsen (U.S. Patent No. 5,761,436), and Feliciano, et al. (U.S. Patent No. 6,052,730). Claims 15 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Judson patent, in view of the citations to Yoda, Nielsen, Feliciano, and

Brown, Borland Quattro Pro User's Guide (1992). Claims 7, 26, and 32-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Judson patent, in view of the patents to Yoda, Nielsen, Feliciano, and Hayashi, et al. (U.S. Patent No. 5,633,996). Claims 39-41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the patent to Judson, in view of the patents to Yoda, Nielsen, and Hunter, et al. (U.S. Patent No. 5,606,690).

*Response to rejections*

In response, while not conceding the propriety of the rejections, independent Claims 1, 16, 27, 28, 29, 31, and 38-41 have been amended. Applicants submit that as amended, independent Claims 1, 16, 27, 28, 29, 31, and 38-41 are allowable for the following reasons.

Independent Claim 1 relates to a method of forming a single printable document by collating a plurality of hyper-text documents. The method comprises the steps of (a) monitoring a user's access patterns to the plurality of hyper-text documents, (b) from the monitoring, accessing the plurality of hyper-text documents including formatting information of the accessed hyper-text documents, and (c) compiling a list of the plurality of accessed hyper-text documents using the structure information, and a formatting step.

Claim 1 has been amended to recite the step of fetching a selected plurality of the accessed hyper-text documents compiled to the list. Claim 1 has also been amended to recite that the formatting step formats the plurality of fetched hyper-text documents using the formatting information into a single continuous printable document in which at least one fetched hyper-text document is spatially contiguously followed by another fetched hyper-text document on the same page of the single continuous printable document.

By this arrangement, multiple documents obtained from different sources can be

formatted onto a single page and different documents from different sources can be formatted onto a single page so that one follows the other spatially contiguously, thereby eliminating any wasted space, as seen in Figure 5 and as described at page 9 of the specification.

In contrast, the patents to Judson, Yoda, Nielsen, Feliciano, et al., and Hunter, et al., at best, merely disclose the printing of each source document on its own page, so that where a source document covers more than one page but less than two pages, the next source document will be printed on a third page, leaving wasted empty space on the second page. Thus, these patents do not disclose or suggest the step of formatting a plurality of fetched hyper-text documents using formatting information into a single continuous printable document in which at least one fetched hyper-text document is spatially contiguously followed by another fetched hyper-text document on the same page of a single continuous printable document, as recited by amended Claim 1.

The failure of the cited documents to disclose or suggest this feature of amended Claim 1 proves fatal to establishing a prima facie case of obviousness against amended Claim 1, since MPEP § 2142 states that:

To establish a prima facie case of obviousness... the prior art reference (or references when combined) must teach or suggest all the claim limitations.

For this reason, amended Claim 1 is allowable over the cited art.

And since these patents also do not disclose or suggest at least one feature of independent Claims 16, 27, 28, 29, 31, and 38-41 (Claim 16 —“form the single contiguous printable document in which the accessed plurality of hyper-text documents are spatially contiguously arranged thereon over at least one printable page thereof”; Claim 27—“at least one said selected document being spatially contiguously followed by another said selected document”; Claim

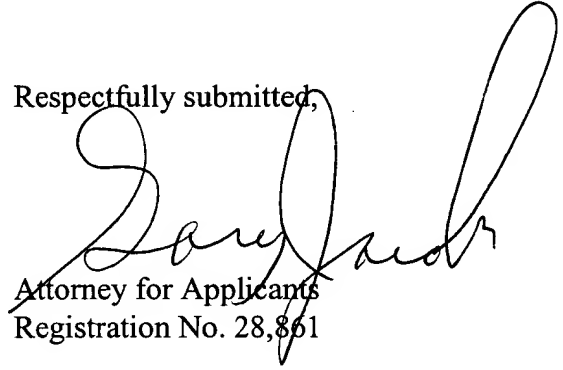
28—“at least one said accessed document is spatially contiguously followed by another said accessed document on the same page of said single printable document”; Claim 29—“at least one said selected document is spatially contiguously followed by another said selected document on a page of said single continuous printable document”; Claim 31—“at least one said accessed hyper-text document is spatially contiguously followed by another said accessed hyper-text document on the same page of said single continuous printable document”; Claim 38—“at least one said fetched hyper-text document is spatially contiguously followed by another said fetched hyper-text document on the same page of said single continuous printable document”; Claim 39—“at least one said fetched hyper-text document is spatially contiguously followed by another said fetched hyper-text document on the same page of said single continuous printable document”; Claim 40—“at least one said fetched hyper-text document is spatially contiguously followed by another said fetched hyper-text document on the same page of said single continuous printable document”; and Claim 41—“at least one said selected document is spatially contiguously followed by another said selected document”), independent Claims 16, 27, 28, 29, 31, and 38-41 are also allowable over these cited patents.

The dependent claims are allowable for the reasons given with respect to the independent claims and because they recite features which are patentable in their own right. Individual consideration of the dependent claims is respectfully solicited.

In view of the above amendments and remarks, the claims are now in allowable form and entry of this Amendment is considered proper. Therefore, early passage to issue is respectfully solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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**VERSION WITH MARKINGS TO SHOW CHANGES MADE TO THE CLAIM**

1. (Four Times Amended) A method of forming a single printable document by collating a plurality of hyper-text documents, said method comprising the steps of:

- (a) monitoring a user's access patterns to the plurality of hyper-text documents;
- (b) from said monitoring, accessing the plurality of hyper-text documents including [structure] formatting information of the accessed hyper-text documents;
- (c) compiling a list of the plurality of accessed hyper-text documents using the structure information; [and]
- (d) fetching a selected plurality of the accessed hyper-text documents compiled to the list; and
- (e) formatting the [list] plurality of fetched hyper-text documents using the [structure] formatting information into [the] a single continuous printable document [comprising each hyper-text document selected from the list] in which at least one said fetched hyper-text document is spatially contiguously followed by another said fetched hyper-text document on the same page of said single continuous printable document.

16. (Four Times Amended) A method of forming a single printable document by collating a plurality of hyper-text documents, said method comprising steps of:

- (a) accessing the plurality of hyper-text documents including corresponding [structure] formatting information of the plurality of hyper-text documents; and;
- (b) collating and formatting the accessed plurality of hyper-text documents using the [structure]

formatting information of the plurality of hyper-text documents and at least a predetermined printable document format to form the single contiguous printable document in which the accessed hyper-text documents are spatially contiguously arranged therein over at least one printable page thereof.

27. (Three Times Amended) A computer implemented method for forming a single continuous printable document by collating a plurality of documents obtained from a plurality of sources, said method comprising the steps of:

monitoring accesses to the plurality of documents in sequence;

recording the contents of a plurality of selected ones of the documents including [structure] formatting information relating to each selected document; and

collating the selected documents according to a predetermined order of collation to form the single continuous printable document, said collating step comprising the step of arranging at least one display page displaying a plurality of the selected ones of the documents according to a size of each selected document based upon the corresponding [structure] formatting information and with at least one said selected document being spatially contiguously followed by another said selected document, wherein the printable document is reproducible at least by printing.

28. (Twice Amended) A computer system comprising:

a network comprising a source of a plurality of documents each individually accessible via a corresponding resource locator and in which the plurality of documents include therein links that afford access to others of the plurality of the documents;

means for monitoring access to the plurality of documents via said resource locator and

compiling a list of accessed ones of the plurality of documents, the list including the corresponding links and [structure] formatting information pertaining to each accessed document; and

means for collating the documents represented in the list into a selected order and for formatting the accessed plurality of documents within the list using the formatting information into a single continuous printable document having at least components corresponding to the accessed documents arranged in the selected order and in which at least one said accessed document is spatially contiguously followed by another said accessed document on the same page of said single printable document.

29. (Three Times Amended) A computer readable medium including instruction modules arranged to collate for printing a single continuous document composed a plurality of documents derived from a plurality of sources in a network, said modules comprising:

a monitoring module for monitoring browsing operations throughout the network;

a compiling module for compiling a list of a selected plurality of documents and corresponding formatting information encountered during the browsing operations;

a collating module for collating user selected ones of the plurality of documents from the list into a single continuous printable document in which each selected document is formatted according to [structure] corresponding formatting information derived during the monitoring and at least one said selected document is spatially contiguously followed by another said selected document on a page of said single continuous printable document; and

a printing module for causing a printing of the single continuous printable document thereby causing hard copy reproduction of [the single printable document and] the selected documents and said one and another [the] selected documents on one page thereof.



31. (Twice Amended) A computer program product having a computer readable medium having a computer program recorded thereon for forming a printable document by collating a plurality of hyper-text documents, said computer program product comprising:

means for monitoring a user's access patterns to the plurality of hyper-text documents;

means for accessing the plurality of hyper-text documents including [structure] formatting information of the accessed hyper-text documents;

means for compiling a list of selected ones of the plurality of hyper-text documents using the [structure] formatting information;

means for fetching a selected plurality of the accessed hyper-text documents compiled in the list; and

means for formatting the [list] plurality of accessed hyper-text documents using the formatting information into [the] a single continuous printable document comprising the selected ones of the accessed hyper-text documents in which at least one said accessed hyper-text document is spatially contiguously followed by another said accessed hyper-text document on the same page of said single continuous printable document.

38. (Amended) A computer implemented method for forming a single continuous printable document by collating a plurality of hyper-text documents, said method comprising the steps of:

(a) initiating a first application for accessing and browsing a plurality of hyper-text documents;

(b) initiating a second application, said second application:

(1) monitoring access patterns of the first application;

(2) fetching a plurality of hyper-text documents accessed by the first application including

corresponding [structure] formatting information of the accessed plurality of hyper-text [document] documents; and

(3) creating a formatted single continuous printable document version of the [accessed] plurality of fetched hyper-text documents using the formatting information in which at least one said fetched hyper-text document is spatially contiguously followed by another said fetched hyper-text document on the same page of said single continuous printable document.

39. (Amended) A method of forming a single printable continuous document by collating a plurality of documents, said method comprising the steps of:

monitoring a user's access patterns to the plurality of documents;

from said monitoring, compiling a list of the plurality of accessed documents in response to monitoring of the user's access to the [document] documents;

displaying the list of the plurality of accessed documents for enabling selection of at least one of the documents to be printed; and

formatting each document selected from the list into the single continuous printable document using the formatting information and in which at least one said fetched hyper-text document is spatially contiguously followed by another said fetched hyper-text document on the same page of said single continuous printable document.

40. (Amended) A method of forming a single continuous printable document by collating a plurality of documents, said method comprising steps of:

accessing the plurality of documents;

compiling a list of the plurality of accessed documents in response to monitoring of user's access to the document;

displaying a list of the plurality of accessed documents for enabling selection of at least one of the documents to be printed; and

collating the plurality of accessed documents selected from the list to form the single continuous printable document in which the plurality of accessed documents selected from the list are contiguously arranged therein over at least one printable page thereof using the formatting information and in which at least one said fetched hyper-text document is spatially contiguously followed by another said fetched hyper-text document on the same page of said single continuous printable document.

41. (Amended) A computer implemented method for forming a single continuous printable document by collating a plurality of documents obtained from a plurality of sources, said method comprising the steps of:

monitoring accesses to the plurality of documents in sequence;

compiling a list of the plurality of accessed documents in response to monitoring of a user's access to the [document] plurality of documents;

displaying a list of the plurality of accessed documents for enabling selection of at least one of the documents to be printed;

recording the contents of [the] selected ones of the documents; and

collating the plurality of selected documents according to a predetermined order of collation to form said single continuous printable document, said collating comprising the step arranging at least one display page displaying a plurality of the selected ones of the documents according to a size of each selected

document, based upon the corresponding formatting information and with at least one said selected document is spatially contiguously followed by another said selected document, wherein the single continuous printable document is reproducible at least by printing.